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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/541,582

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Nicholas Barson Mebberson

21854-00060-US1

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CONNOLLY BOVE LODGE & HUTZ LLP  
1875 EYE STREET, N.W.  
SUITE 1100  
WASHINGTON, DC 20036

EXAMINER

MAYES, MELVIN C

ART UNIT

PAPER NUMBER

1791

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/541,582	<b>Applicant(s)</b> MEBBERSON ET AL.	
	<b>Examiner</b> Melvin C. Mayes	<b>Art Unit</b> 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) 1-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-57, 59, 61 and 62 is/are rejected.
- 7) ☒ Claim(s) 58 and 60 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/7/05</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

(1)

Applicant's election of Claim 27-62 in the reply filed on March 28, 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Information Disclosure Statement***

(2)

The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been considered. Applicant is advised that the date of submission of any item of information or any missing

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element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

(3)

The information disclosure statement filed July 7, 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

***Claim Rejections - 35 USC § 112***

(4)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

(5)

Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 35 recites the limitation "the conveyor means." There is insufficient antecedent basis for this limitation in the claim.

Claim 51 recites the limitation "each carriage." There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

(6)

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(7)

Claims 27-32, 34, 35, 37-42, 44-51, 53, 54, 61 and 62 are rejected under 35 U.S.C. 102(e) as being anticipated by Matheson 2004/0178168.

Matheson discloses an apparatus for making a container stopper comprising:

stopper holding means 11 in the form of a die to hold the stopper with its end adjacent a polymeric film (means for positioning the stopper);

cutter end on the die to cut the film (means for cutting); and

backing plate 16 to press the film onto the end of the stopper (means for bonding) [0055]-[0082].

Regarding Claims 28-32 and 34, the stopper holding means can be moved relative to the film to press the stopper and film together and a number of dies can be arranged on a axle or slide to advance the dies [0064]-[0065].

Regarding Claims 35 and 62, the axle or slide advances to a position to present a new stopper to be treated and the treated stopper is punched out with a ram and replaced [0065].

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Regarding Claims 37-39, the means for cutting is a cutter end on the die which is movable relative to the film.

Regarding Claim 40, the film is provided as a continuous film spooled between two holding elements to advance the film [0062].

Regarding Claims 41 and 42, means can be provided to apply an adhesive layer to the film prior to application to the stopper body [0039].

Regarding Claims 41, 42 and 44, the film can be heated prior to the pressing step by means of heated air or gas or heating chamber [0063].

Regarding Claims 41, 42 and 44-51, the film can be heated by the backing plate that is movable to force the film onto the stopper [0063]-[0064].

Regarding Claim 61, the die can be configured so that two ends of the stopper can be treated simultaneously [0060].

### ***Claim Rejections - 35 USC § 103***

(8)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

(9)

Claims 33, 36, 43, 52, 55-57 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matheson.

Regarding Claim 33, Matheson teaches that the die are arranged on an axle or slide so that the process can be run as a continuous process [0065]. It would have been obvious to one of ordinary skill in the art that to run the axle in a continuous process, the axle or slide is provided to rotate such as on a rotary table or drum.

Regarding Claim 36, Matheson teaches that a treated stopper is punched out with a ram and replaced in the die with a new stopper. It would have been obvious to one of ordinary skill in the art to have provided a container for containing stoppers to be placed into the dies for film application.

Regarding Claims 43 and 52, Matheson teaches that an adhesive layer can be applied to the film prior to application to the stopper body such as by spray [0039]. It would have been obvious to one of ordinary skill in the art that an alternative to applying the adhesive to the film would be to provide means to spray the adhesive onto the stopper body. It would have been obvious to one of ordinary skill in the art that the same effect of applying adhesive for bonding the film to the stopper is achieved whether the adhesive is applied to the film or the stopper, and thus spraying adhesive on either the film or the stopper would have been obvious to one of ordinary skill in the art as alternatives for achieving the same effect of application Of adhesive for bonding.

Regarding Claims 55-57, Matheson teaches that the film is heated prior to or simultaneously with the pressing step then is punched out with a ram and replaced in the die with a new stopper and that the process is configured to run as a continuous process to be relatively efficient and time and cost-effective [0063], [0065]. It would have been obvious to one of ordinary skill in the art to make the process more time efficient by providing means such as a press to cool the film after the film is pressed to the stopper as cooling the film would reduce the time between pressing and removing the stopper from the die for replacing with a new stopper.

Regarding Claim 59, Matheson teaches that the die can be configured so that both ends of the stopper can be treated with film. It would have been obvious to one of ordinary skill in the art to that providing means to invert the die, and thus invert the stopper, would allow both ends of the stopper held by the die to be treated with a single film instead of using two films for treating both ends, as both methods achieve the same function of treating both ends of a stopper.



***Allowable Subject Matter***

(10)

Claim 58 and 60 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin C. Mayes whose telephone number is 571-272-1234. The examiner can normally be reached on Mon-Fri 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Phillip C. Tucker can be reached on 571-272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

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like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melvin C. Mayes  
Primary Examiner  
Art Unit 1791

MCM  
June 20, 2008

/Melvin C. Mayes/  
Primary Examiner, Art Unit 1791